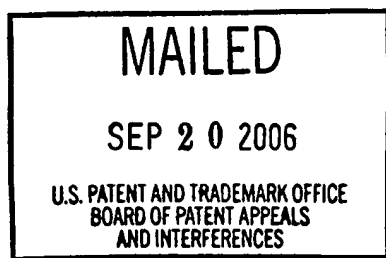


The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN E. RODE



Appeal No. 2006-0822
Application No. 10/054,253
Technology Center 3600

ON BRIEF

Before FRANKFORT, BAHR and FETTING, *Administrative Patent Judges*.
BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1-6, 8, 9, 13, 14, 16, 24, 25 and 28-32. Claims 10-12, 15, 17-23, 26 and 27 have been withdrawn from consideration. The status of claim 7 is unclear, as explained *infra*, and should be clarified upon return of this application to the jurisdiction of the primary examiner. No other claims are pending in the application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to an adjustable disc spring system and method of utilizing such a system. A copy of the claims under appeal is set forth in the appendix to the appellant's brief. Claim 16, which is representative of the claimed invention, is reproduced *infra*.

The examiner relies upon the following as evidence of unpatentability:

Teeri	US 3,836,195	Sep. 17, 1974
Rode	US 4,067,585	Jan. 10, 1978

The following rejections are before us for review.¹

Claims 16, 24, 25 and 28² stand rejected under 35 U.S.C. § 102(b) as being anticipated by Teeri.

Claims 1-6, 8, 9, 13, 14 and 29-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Teeri in view of Rode.

Rather than reiterate in their entirety the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the

¹ Normally, a rejection will be assumed to be withdrawn because of an examiner's failure to carry such rejection forward and to restate it in the answer. *Ex parte Emm*, 118 USPQ 180, 181 (Bd. App. 1957). The rejection of claim 7 under 35 U.S.C. § 103 set forth in the final rejection (mailed July 7, 2004) is therefore assumed to be withdrawn, in view of the examiner's failure to restate it in the answer, and has not been reviewed as part of this appeal.

² As explained by the examiner (answer, p. 3), the examiner inadvertently included claim 28 in the rejection based on Teeri in view of Rode in the final rejection.

examiner's answer (mailed July 7, 2005) for the examiner's complete reasoning in support of the rejections and to the appellant's brief (filed April 29, 2005) and reply brief (filed September 9, 2005) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied Teeri and Rode patents, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the following determinations.

We turn our attention first to the anticipation rejection. The appellant has not argued claims 24, 25 and 28 separately from claim 16. Therefore, in accordance with 37 CFR § 41.37(c)(1)(vii), we have selected claim 16 as the representative claim to decide the appeal on this rejection, with claims 24, 25 and 28 standing or falling therewith.

Claim 16 reads as follows.

16. An adjustable spring system comprising:
a plurality of beveled disc springs axially aligned
with an adjustable spacer;
wherein said adjustable spacer is plastically
compressible in a substantially axial direction relative to
said plurality of beveled disc springs.

Teeri discloses a Belleville disk spring pillar assembly comprising Belleville springs 1 bound into one assembly with binding rings 2 at their outer rims and with

binding rings 3 at their inner rims. In the Figure 4 embodiment, the binding rings are made of steel plate rings (col. 2, ll. 5-7). As explained in the last full paragraph in column 2, the binding rings or part of the binding rings can be made of an elastic material, such as rubber or synthetic rubber. In Figures 9 and 11, inner ring 14 is reinforced with metal ring 15, which has been vulcanized to elastic part 14.

Noting that Teeri discloses metal (steel) as the material for the spacer (binding ring 2), the examiner's position in rejecting claim 16 is that Teeri's metal binding ring is plastically compressible since it is an inherent property of metal to be plastically compressible when the amount of force being applied has exceeded the elasticity of the metal (answer, p. 4). The examiner (answer, p. 7) adds that rubber and metal, the two materials mentioned by Teeri for the binding rings, are both plastically compressible.

The appellant argues that there is no disclosure that the binding rings of Teeri are made of plastically compressible material, as recited in claim 16, or that adjustment of such binding rings by a force is desirable. In fact, the appellant notes that the binding rings of Teeri are described as being elastic (col. 2, ll. 57-60, in the case of rubber rings) and depicted as rigid (Figures 4 and 6) but not as being plastically deformable or adjustable (brief, pp. 4 and 5).

On page 3 of the reply brief, the appellant argues that, even if the binding rings may be made of metal, and an inherent property of metal is its plastic compressibility, there is no disclosure in Teeri that Teeri's binding rings will plastically compress in an axial direction, much less that they will *always* compress

in an axial direction. According to the appellant, the alleged compressibility could cause the binding rings to be plastically compressed in any number of directions offset from a substantially axial direction relative to the plurality of beveled disc springs. *Id.*

Initially, we note that the appellant has not contested the examiner's statements that metals are plastically compressible and that the metal binding rings disclosed by Teeri are plastically compressible when subjected to a force that exceeds their elastic limit. Instead, the appellant appears to be arguing that there is no indication in Teeri that plastic compressibility or adjustability of the binding rings is desirable or that Teeri's binding rings will *always* be compressed in an axial direction relative to the beveled disc springs under application of any force. While it is true that Teeri gives no indication that plastic compressibility or adjustability is specifically desired, anticipation does not require that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984). Claim 16 does not require that the adjustable spacer plastically compress in an axial direction when subjected to any and every force or under any particular conditions or that it compress in a completely axial direction. The claim merely calls for the spacer to be plastically compressible in a *substantially* axial direction; it does not specify the conditions under which such compression must occur or require that it *always* so

compress under any amount of force applied in any direction or that it be compressed under the normal operating conditions of the Teeri disc spring pillar assembly. Accordingly, the fact that the binding ring may not compress under the load conditions illustrated in Figures 4 and 6 is immaterial to the issue of whether Teeri meets the limitations of claim 16.

For the reasons set forth above, we do not find appellant's arguments persuasive that the subject matter of claim 16 is not anticipated by Teeri. We therefore sustain the rejection of claim 16 and claims 24, 25 and 28 that stand or fall therewith.

We turn our attention now to the rejection of claims 1-6, 8, 9, 13, 14 and 29-32 as being unpatentable over Teeri in view of Rode. We agree with the appellant that one of ordinary skill in the art would not have found any suggestion in the combined teachings of Teeri and Rode to modify Teeri's disc spring assembly to include a spacer of the type taught by Rode or to compress such spacer to plastically deform it. Accordingly, we shall not sustain the rejection of method claims 29-32 as being unpatentable over Teeri in view of Rode.

We shall, however, sustain the rejection of claim 1, and dependent claims 2-6, 8, 9, 13 and 14 which the appellant has not argued separately from claim 1, as being unpatentable over Teeri in view of Rode. For the reasons discussed above with respect to claim 16, we conclude that claim 1 reads on the structure of Teeri. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of

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obviousness.” *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). *See also In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); *In re Pearson*, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-6, 8, 9, 13, 14, 16, 24, 25 and 28-32 is affirmed as to claims 1-6, 8, 9, 13, 14, 16, 24, 25 and 28 and reversed as to claims 29-32. The rejection of claim 7 set forth in the final rejection is assumed to have been withdrawn and has not been reviewed as part of this appeal.

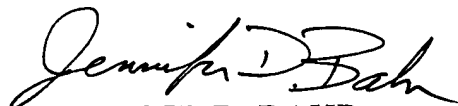
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No time period for taking any subsequent action in connection with this
appeal may be extended under 37 CFR § 1.136(a).

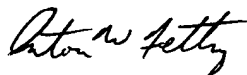
AFFIRMED-IN-PART



CHARLES E. FRANKFORT
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge



ANTON W. FETTING
Administrative Patent Judge

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